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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,188	12/09/2005	Serge Tetart	264665US0PCT	1490
22850	7590	12/11/2006	EXAMINER NILAND, PATRICK DENNIS	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/522,188

Applicant(s)

TETART, SERGE

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-21 is/are rejected.
- 7) ☒ Claim(s) 15 and 22-24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Art Unit: 1714

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4525488 Cuscurida et al..

Cuscurida discloses a liquid Mannich reaction product of phenol, formaldehyde, and amino alcohols including monoethanol amine and preferably diethanolamine. See the abstract; column 3, lines 6-68; column 4, lines 1-6; and column 6, lines 54-68. It is expected to be necessarily and inherently dilutable with water according to the instant claims since it is apparently the same resin as required of the instant claims and must therefore have similar physical properties including dilutability. It is expected to have the ability to be used in sizing fibers because it is the same resin as required of the instant claims. No probative evidence to the contrary is seen. The patentee is silent regarding free formaldehyde and free phenol contents. However, since the reaction is the same as that of the instant claims, the reaction product of the patentee is expected to have the formaldehyde content of the instant claims 6 and 8 and the phenol content of the instant claims 7 and 8 because it uses no excess of formaldehyde nor phenol. The patentee is silent as to ash content. The Mannich reaction product of the patentee's example 1 is expected to necessarily and inherently have the ash content of the instant claim 9 because it contains no ash forming compounds such as inorganic bases and is otherwise the same combination of reactants as used by the instant claims. "About" of column 4, lines 1-6 encompasses a slight excess of formaldehyde over phenol, particularly within the limits of which one can accurately measure

these amounts. Any excess of formaldehyde, even very small, reads on the instant claim 10.

The process of reaction of the patentee is that of the instant claims 10-14.

3. Claims 1-12, 14, 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 3876405 Eilerman.

Eilerman discloses a sizing composition for glass fibers containing the Mannich reaction product of the instant claims 1-9 made by the method of the instant claims 10-12 and 14 at the abstract; column 1, lines 1-68; column 2, lines 1-68; column 3, lines 1-68; column 4, lines 1-68, particularly 21-68; column 5, lines 1-68, particularly 1, 4, 7, 13, and 30-68 of which the sodium perborate is expected to be able to crosslink the Mannich reaction products and therefore falls within the scope of the instant claim 16 as could the anhydride of line 57 and the triethoxy silane of claim 3; column 6, lines 1-57; and the remainder of the document. The Mannich reaction product of the patentee is expected to be necessarily and inherently dilutable with water according to the instant claims since it is apparently the same resin as required of the instant claims and must therefore have similar physical properties including dilutability. No probative evidence to the contrary is seen. The patentee is silent regarding free formaldehyde and free phenol contents. However, since the reaction is the same as that of the instant claims, the reaction product of the patentee is expected to have the formaldehyde content of the instant claims 6 and 8 and the phenol content of the instant claims 7 and 8 because it uses no excess of formaldehyde nor phenol. The patentee is silent as to ash content. The Mannich reaction product of the patentee's example 1 is expected to necessarily and inherently have the ash content of the instant claim 9 because it contains no ash forming compounds such as inorganic bases and is otherwise the same combination of reactants as used by the instant claims.

4. Claims 15 and 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art considered does not teach the limitations of these claims nor suggest modifying the prior art to give these claimed inventions.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
Art Unit 1714